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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,186

03/02/2005

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EXAMINER

VAUGHAN, MICHAEL R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,186	Applicant(s) KASTELEWICZ ET AL.	
	Examiner MICHAEL R. VAUGHAN	Art Unit 4148	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/02/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The instant application having Application No. 10/526186 filed on 03/02/2005 is presented for examination by the examiner.

Oath/Declaration

The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in instant Application No. 10/526186, filed on 03/02/2005.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 03/02/2005 was filed on 03/02/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because drawings submitted are not in English. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: all numbers below 100. Examiner cannot determine whether numbers correspond to specification because much of the text labels are in a foreign language. In the Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: needs to disclose all reference characters from the figures.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Appropriate correction is required.

Double Patenting

101 Statutory Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 11/047618. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

101 Nonstatutory Double Patenting

Art Unit: 2131

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11 and 26 of copending Application No. 10/563,939 in view of US Patent Application 2007/0150608 A1 to Randall et al. Randall teaches that is it advantageous to incorporate digital rights management in peer-to-peer networks in order to protect content from piracy (0010). Randall teaches that the content providers can use any means of DRM to protect and enhance the content provided to the mobile devices. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the digital right management service into the pending application 10/563,939.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between claims 1 and 13 of the instant application and claims 11 and 26 of the other pending application is that the following language was added to claims 1 and 13 of the instant application:

Claim 1:

"wherein at least one digital rights management service is installed in the superpeer host computer, by means of which digital rights management service usage rights with regard to an electronic file which is transmitted from or to the mobile radio network-fixed network interface computer are specified."

Claim 13:

"wherein an electronic file identified by the superpeer host computer according to the mobile radio peer-to-peer message is processed according to a digital rights management service installed in the superpeer host computer"

Claims 1 and 13 of the instant application are compared to claims 11 and 26 of the pending application in the table below:

Instant Application 10/526,186	Pending Application: 10/563,939
Claim 1, a communication system, comprising: a fixed communication network; a mobile radio communication network; a mobile radio network-fixed network interface computer which is connected to the fixed communication network and to the mobile radio communication network for mapping a	Claim 11, a communication system, comprising: a fixed communication network; a mobile radio communication network; a mobile radio network-fixed network interface computer which is connected to the fixed communication network and to the mobile radio communication network for mapping a

<p>data stream between the fixed communication network and the mobile radio communication network;</p> <p>a superpeer host computer which is connected to the mobile radio network-fixed network interface computer; and</p> <p>a peer-to-peer message filter which is disposed in the mobile radio communication network and which is set up such that peer-to-peer messages supplied to the peer-to-peer message filter from the mobile radio communication network are identified and can be delivered to the superpeer host computer,</p> <p>wherein at least one digital rights management service is installed in the superpeer host computer, by means of which digital rights management service usage rights with regard to an electronic file which is transmitted from or to the mobile radio network-fixed network interface computer are specified.</p> <p>Regarding Claim 13, A method for processing a peer-to-peer message, comprising:</p> <p>identifying a mobile radio peer-to-peer message by a peer-to-peer message filter computer disposed in a mobile radio communication network;</p> <p>transmitting the mobile radio peer-to-peer message to a superpeer computer connected to a mobile radio network-fixed network interface computer; and</p>	<p>data stream between the fixed communication network and the mobile radio communication network;</p> <p>a superpeer host computer which is connected to the mobile radio network-fixed network interface computer; and</p> <p>a peer-to-peer message filter which is disposed in the mobile radio communication network and which is set up such that peer-to-peer messages supplied to the peer-to-peer message filter from the mobile radio communication network are identified and can be delivered to the superpeer host computer.</p> <p>Claim 26, a method for processing a peer-to-peer message in a communication system comprising:</p> <p>detecting a mobile radio peer-to-peer message with a computer comprising a peer-to-peer message filter disposed in a mobile radio communication network;</p> <p>mapping the mobile radio peer-to-peer message to a superpeer computer connected to a mobile radio network/fixed interface computer; and</p>
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processing the mobile radio peer-to-peer message by the superpeer host computer, wherein an electronic file identified by the superpeer host computer according to the mobile radio peer-to-peer message is processed according to a digital rights management service installed in the superpeer host computer.	processing the mobile radio peer-to-peer message by the super computer
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In further, dependent claims 4-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-18 of copending Application No. 10/563,939. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only differences between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations in claims 4-10 of the instant application and claims 12-18 of the pending application.

Instant Application 10/526,186	Pending Application: 10/563,939
Claim 4, The communication system according to claim 1, wherein the fixed communication network is based on internet protocols.	Claim 12, The communication system according to claim 11, wherein the fixed communication network is based on internet protocols.
Claim 5, The communication system according to claim 1, wherein	Claim 13, The communication system according to claim 11, wherein

<p>the superpeer host computer is disposed in the mobile radio communication network.</p> <p>Claim 6, The communication system according to claim 1, wherein the mobile radio communication network is based on a mobile radio system of the third or a succeeding generation.</p> <p>Regarding Claim 7, The communication system according to claim 6, wherein the mobile radio communication network is based on one of the following mobile radio communication networks: Universal Mobile Telecommunications System, or Future Public Land Mobile Telephone System.</p> <p>Regarding Claim 8, The communication system according to claim 1, wherein the mobile radio communication network is based on a mobile radio communication network according to Groupe Speciale Mobile.</p> <p>Regarding Claim 9, The communication</p>	<p>the superpeer host computer is disposed in the mobile radio communication network.</p> <p>Claim 14, The communication system according to claim 11, wherein the mobile radio communication network is based on a mobile radio system of the third or a succeeding generation.</p> <p>Regarding Claim 15, The communication system according to claim 14, wherein the mobile radio communication network is based on one of the following mobile radio communication networks: Universal Mobile Telecommunications System, or Future Public Land Mobile Telephone System.</p> <p>Regarding Claim 16, The communication system according to claim 8, wherein the mobile radio communication network is based on a mobile radio communication network according to Groupe Speciale Mobile platform.</p> <p>Regarding Claim 17, The communication</p>
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<p>system according to claim 6, wherein the mobile radio communication network is based on the Universal Mobile Telecommunications System, and the mobile radio network-fixed network interface computer is a Gateway GPRS Support Node computer.</p> <p>Regarding Claim 10, The communication system according to claim 1, further comprising an installation mechanism which is set up such that a peer-to-peer service is installed in the superpeer computer if the service is requested sufficiently frequently.</p>	<p>system according to claim 15, wherein the mobile radio communication network is based on the Universal Mobile Telecommunications System platform, and the mobile radio network/fixed network interface computer is a Gateway GPRS Support Node computer.</p> <p>Regarding Claim 18, The communication system according to claim 11, further comprising an installation trigger of peer-to-peer service in the superpeer computer when the frequency of demand for the peer-to-peer service reaches a threshold value.</p>
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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 6, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 3, the word [it] in line 3 renders the claim indefinite because the [it] could refer to more than one object, i.e. the communication system or the digital rights provider computer.

As per claim 6, [the third or a succeeding generation] clause is indefinite. For examination on the merits, examiner is treating this limitation to mean a mobile radio system of the third generation or a succeeding generation.

As per claim 10, [service] renders the claim indefinite. The claim discloses an installation mechanism which is set up such that a peer-to-peer **service** is installed in the superpeer computer if *the service* is requested. (Emphasis added) It is not likely that the latter service refers to the former because logically the service would already be in place if it had been requested a first time. For examination on the merits, examiner is interpreting the service being some type of service needed different than a peer-to-peer service.

Claim 11 recites the limitation [the computers] in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent Application Publication US 2007/0150608 A1 to Randall et al., hereinafter
Randall.

As per claim 1, Randall teaches a fixed communication network (Fig 6), a mobile radio communication network (Fig 6), a mobile radio network-fixed network interface computer which is connected to the fixed communication network and to the mobile radio communication network for mapping a data stream between the two networks (in Figure 6, the GRPS protocol is used to provide communication between the mobile radio network and the fixed network, it is inherent that a gateway router/computer is present even though it is not drawn; for the system to work it must be between the radio tower and the LAN),
a superpeer host computer [dedicated server] which is connected to the mobile radio network-fixed network interface computer (0038),
and a peer-to-peer message filter [present in both the mobile device as API (0009) and the ADS system server (0394)] which is disposed in the mobile radio communication network and which is setup such that peer-to-peer messages supplied to the peer-to-peer message filter from the mobile radio communication network are identified and can

be delivered to the superpeer host computer[commercial data service providers as in 0038](0009); as an example Randall teaches that the ADS system server can receive a peer-to-peer message sent by the mobile device, identifies where it should go, and routes the message to the designated server [0394]. In Randall's system the mobile device can filter messages and display them appropriately for the device and the ADS system server filter messages from the mobile devices to the correct content provider or other servers.

wherein at least one digital rights management service [DRM] is installed in the superpeer host computer, by means of which digital rights management service usage rights with regard to an electronic file which is transmitted from or to the mobile radio network-fixed network interface computer are specified (0010). Randall teaches that the content providers can use any means of DRM to protect and enhance the content provided to the mobile devices.

As per claim 2, Randall teaches at least one digital rights management service is setup for at least one of the following is performed on the electronic file: a digital rights management coding scheme by means of which it is specified that the electronic file will become unusable after a predefined time has elapsed or at a predefined time; modifying the contents of the electronic file; removing part of the electronic file, scanning for a computer virus, a worm, or a Trojan horse; and signing the contents of the electronic file (0010, 0024).

As per claim 3, Randall teaches a digital rights provider computer [Fig 6's Security Services] which is connected to the super peer host computer and is setup such that it transmits to the superpeer host computer the rights to be taken into account for the electronic file in each case (0010 and 0024).

As per claim 4, Randall teaches the fixed communication network is based on internet protocols (0311).

As per claim 5, Randall teaches the superpeer host computer is disposed in the mobile radio communication network (Fig 6). The word disposed is given its broadest meaning since the examiner did not find a special meaning of the word in Applicant's disclosure. According to Dictionary.com's website disposed means "to put in a particular or the proper order or arrangement; adjust by arranging the parts." Examiner chose this definition because the parts of the system must be in an order to carry out the functions of the invention. Therefore the superpeer host computer is operatively connected to the mobile network via the fixed network.

As per claim 6, Randall teaches the mobile radio communication network is based on a mobile radio system of the 3rd or succeeding generation (0006 and 0387).

As per claim 7, Randall teaches the mobile radio communication network is based on one of the following networks: UMTS and FPLMTS (0003).

As per claim 8, Randall teaches the mobile radio communications network is based on Group Special Mobile, GSM (0005).

As per claim 9, Randall teaches the mobile radio communication network is based on UMTS (0003) and the mobile radio network-fixed network interface computer is a Gateway GPRS Support Node computer (0381).

As per claim 10, Randall teaches an installation mechanism [access control methods] which is setup such that a peer to peer service is installed in the superpeer computer [server] if the service is requested sufficiently frequently (0071).

As per claim 11, Randall teaches the superpeer host computer has installed at least one search service by means of which information relating to the electronic file is determined by the computers provided in the fixed communications network and made available for further processing (0010, 0082, and 0083). In this example, Randall teaches the Yellow pages as a content provider [superpeer host computer] whereby it receives requests for searches from a mobile client.

As per claim 12, Randall teaches a peer to peer [shared with others] superpeer host computer (0016) has installed at least one digital rights management service [authentication] by means of which usage rights with regard to an electronic file [data object] which is transmitted from or to the mobile radio network-fixed network interface [pushed] (0016) computer are specified.

As per claim 13, Randall teaches a method for processing a peer-to-peer message comprising [see abstract and 0016], identifying a mobile radio peer-to-peer message by a peer-to-peer message filter computer [present in the mobile device as API (0009 and 0023)] disposed in a mobile radio communication network (see abstract);
transmitting the mobile radio peer-to-peer message to a superpeer computer [dedicated server] (0038) connected to a mobile radio network-fixed network interface computer (Fig 6);
processing the mobile radio peer-to-peer message by the superpeer host computer (0023);
processing and electronic file [object] (0024) identified by the superpeer host computer according to the mobile radio peer-to-peer message according to a digital rights management service [DRM] (0010) installed in the superpeer host computer [data service provider] (0023).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication US 200/0004875 A1 to Kontio et al discloses a mobile communication environment to obtain rights to protected content of a digital asset.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./
Examiner, Art Unit 2131

/Ayaz R. Sheikh/

Supervisory Patent Examiner, Art Unit 2131